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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. HARTIGAN

Appeal 2009-4303
Application 09/862,577
Technology Center 3600

Decided:¹ May 18, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

William R. Hartigan (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-4, 6-9, and 11-22. Claims 5 and 10 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.²

THE INVENTION

The invention relates to providing insurance information across a computer network.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method for providing insurance information across a network, comprising:
 - receiving an access code from a user via the network;
 - receiving a password from a user via the network;
 - executing computer-implemented instructions for determining a user class of the user from the access code and password, the user class being one of an agent or a certificate holder;
 - in the event that the user is an agent, permitting the agent to enter insurance information including a certificate of insurance for an insured;
 - storing the insurance information along with the date and time of entry as a record in a database;
 - executing computer-implemented instructions for generating an access code and password corresponding to the insured;

² Our decision will make reference to the Appellant's Appeal Brief ("Br.," filed Sep. 22, 2007) and the Examiner's Answer ("Answer," mailed Jan. 4, 2008).

in the event that the user is a certificate holder, permitting the certificate holder to view insurance information for the insured corresponding to the insured's access code and password;

receiving a set of insurance requirements from the certificate holder via the network;

executing computer-implemented instructions for comparing the set of insurance requirements from the certificate holder to the insurance information for the insured to determine if the insurance information complies with the set of insurance requirements; and

executing computer-implemented instructions for displaying an exception report to the certificate holder if the insurance information fails to comply with any of the set of insurance requirements, the exception report indicating which of the insured's insurance information violated the set of insurance requirements.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Sexton	US 5,752,236	May 12, 1998
Aquila	US 2002/0035488 A1	Mar. 21, 2002
Almeida	US 2004/0083125 A1	Apr. 29, 2004

The following rejection is before us for review:

1. Claims 1-4, 6-9, and 11-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Almeida, Aquila, and Sexton.

ARGUMENTS

The Brief's focus is on the rejection of claim 1. In that regard, the appellant makes two arguments.

First, the Appellant argues that Aquila claims priority to a provisional patent application having a filing date prior to the earliest date of priority to

which the Appellant asserts he is entitled to which the Examiner has not shown includes the disclosure relied on in Aquila to reject the Appellant's claims and thus has not made a *prima facie* case under § 103. Br. 7. The Examiner did not respond to this argument.

Second, the Appellant argues that the prior art has a purpose and function unrelated to the claimed invention. According to the Appellant, the claimed invention relates to insurance certificates and compliance with insurance requirements while Almeida and Aquila are directed to settling insurance claims and Sexton is directed to regulatory compliance. Br. 7-8.

The Examiner responded to the second argument by relying on "the clear teaching of Almeida for such a feature (See page 4, Paragraph 0050; Page 6, Paragraphs 0068-0072)." Answer 16 (see also Final Rejection 5).

The Appellant disputes the Examiner's understanding of Almeida.

In particular, Applicant believes the Examiner confused the "digital certificate" in the primary reference, Almeida, with "certificates of insurance" and "certificate holder" recited in the claims. With reference to claim 1, for example, the Examiner relies heavily on paragraphs 0048-0057 [sic., 0068-0072?] in Almeida as disclosing various recitations including "certificates of insurance" and "certificate holder." These citations explain the use of digital signatures to authenticate the identity of parties using the Almeida system, using information such as name, location, and/or a private identification number (PIN), while the Applicant's system uses insurance policy data to create an insurance certificate as evidence of insurance for the certificate holder. The Applicant's system uses the combination User Name / Password to identify the user as either an 'agent' or 'certificate holder.'

Br. 8.

ISSUES

The issues are:

(1) Was the Examiner obligated to show that the disclosure relied upon in Aquila to support the rejection is included in the provisional patent application to which Aquila claims priority?

(2) Does Almeida disclose "certificates of insurance" and "certificate holder" as recited in the claims and, if not, is the distinction between the "certificates of insurance" and "certificate holder" as claimed and what Almeida discloses a patentable one?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. This application (09/862,577) has a filing date of May 21, 2001 and claims priority to 60/205,477, filed May 19, 2000.
2. Aquila has a filing date of Apr. 3, 2001 and claims priority under 35 U.S.C. § 119(e) to 60/194,128, filed Apr. 3, 2000.

Claim construction

3. Claim 1 is drawn to a method which calls for receiving an access code and password from a user via a network and executing computer-implemented instructions for determining a user class for the user from the access code and password, the user class being one of an agent or a certificate holder.
4. The method of claim 1 describes additional steps which can be

- conducted depending on whether the user is determined to be an agent or a certificate holder.
5. If the user is an agent, the method of claim 1 “permit[s] the agent to enter insurance information including a certificate of insurance for an insured.”
 6. According to the Specification, a “certificate of insurance” is a proof of insurance furnished by a provider of a service or product, especially where the product creates a risk of injury. Specification 1:14-18.
 7. According to the Specification, a ““certificate holder”” is the recipient of the “certificate of insurance,” as opposed to the ““insured”” which is the provider of the service or product who is insured by the policy indicated on the “certificate of insurance.” Specification 1:20-22.
- The scope and content of the prior art*
8. Almeida relates to coordinating customer services provided by a plurality of independent insurance agents.
 9. Almeida [0050] reads:

[0050] In one embodiment of the invention, the digital certificate is an X.509 certificate. The X.509 certificate allows users to identify themselves remotely, and locally. The certificates may be installed on Windows® 95, Windows® NT. The digital certificates primarily contain information about the holder's identity such as name, location, and/or a private identification number (PIN) obtained upon registering for access to the electronic common area 216. In one embodiment of the invention, the holder's identification is placed in an X.500 library that is used as a look-up table for users having proper access authority. The digital certificate is generally signed by a certificate authority. In one embodiment of the invention, the certificate authority can be the insurance carrier. However, the authorizing authority can be another entity solely responsible for network security.
 10. Almeida [0068] reads:

[0068] A member services icon 418 provides an electronic link to a web page having communication links to the insurance carrier. In this location, the agent 110 is able to obtain various forms relevant to the industry, and sanctioned by the insurance carrier. In addition, the agent 110 is able to access information from other agents via an informational question and answer message board, and by sending/receiving electronic mail. The agent may also communicate with the insurance carrier regarding services being provided.

11. Almeida [0069] reads:

[0069] An electronic mail icon 420 provides access to a messaging system. In one embodiment of the invention, the messaging system utilizes standard simple mail transfer protocol (SMTP) which is a method for transmitting electronic mail to and from the INTERNET. In another embodiment, the messaging system may utilize an internet message access protocol (IMAP) mail service that enables an authorized local user to access electronic mail messages from a stand alone computer, workstation or laptop computer without transferring files between an agent 110, a vendor 108, and the server 104.

12. Almeida [0070] reads:

[0070] An INTERNET access icon 422 provides access to a portal that directly links the agent 110 with the global communications network 114. In one embodiment of the invention, the global communications network 114 is the INTERNET. In one embodiment of the invention, when the agent enters the INTERNET, the border around the web page identifying the insurance carrier is removed signifying that the agent 110 is no longer within the agents virtual electronic community 216.

13. Almeida [0071] reads:

[0071] A site search icon 424 allows the agent 110 to search the virtual electronic community web site and provides an electronic link for searching the INTERNET.

14. Almeida [0072] reads:

[0072] Embodiments of the present invention overcome problems associated with the prior art in providing a single virtual location in which independent insurance agents, insurance related vendors and an

insurance carrier are able to dispense insurance related services, and a single location in which customers are able to resolve their insurance related needs. Having thus described at least one illustrative embodiment of the invention, various modifications, alterations, and improvements are intended to be within the scope and spirit of the invention.

15. Aquila relates to insurance claim processing.

16. Sexton relates to life insurance plans.

Any differences between the claimed subject matter and the prior art

17. The difference between the claimed subject matter and the prior art is that the prior art does not clearly disclose "certificates of insurance" and "certificate holder."

The level of skill in the art

18. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of providing information over a network. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'"') (*quoting Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

19. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying

factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

Claim 1

The Appellant correctly points out that Aquila has a filing date of Apr. 3, 2001, which is prior to the effective filing date but after the priority date of the present application. FF 1 and 2. However, Aquila claims priority under 35 U.S.C. § 119(e) to 60/194,128, filed Apr. 3, 2000, and that date is before the priority date of the present application. FF 1 and 2. The Appellant would have the Examiner provide a showing that the subject matter the Examiner relied upon in Aquila to reject the claim is included in the 60/194,128 provisional application. Because such a showing is alleged not to be of record, the Appellant would have us now find that Aquila is not entitled to the filing date of 60/194,128, thus rendering Aquila inapplicable as prior art and, as a result, finding that the *prima facie* case of obviousness over Almeida, Aquila, and Sexton has not been established.

We decline to find that the Examiner in this case was obligated to provide a showing that the subject matter the Examiner relied upon in Aquila to reject the claim is “included” in the 60/194,128 provisional application.

First of all, the test for determining whether Aquila may be relied upon is whether the 60/194,128 provisional application properly supported the subject matter relied upon to make the rejection in compliance with § 112, first paragraph, and not, as the Appellant has argued, whether 60/194,128 “includes” the subject matter relied upon in Aquila.

Secondly, the 60/194,128 provisional application was readily available in Public PAIR. The Appellant does not explain why the Appellant did not avail himself of Public PAIR to determine whether the subject matter relied upon in Aquila is “included” in 60/194,128. Nor does the Appellant explain why the Appellant could not have performed this simple task during all this the time since the Appellant was first made aware of Aquila. *Cf. Ex parte Yamaguchi*, 88 USPQ2d 1606, 1613 (BPAI 2008) (precedential) (The Examiner had noted that the provisional application was readily available in the PAIR system.) Accordingly, we see no good reason to shift the burden now back to the Examiner to provide the argued-for showing.

Third, the Examiner relied on Aquila only as evidence that the prior art discloses the claim limitation “storing the insurance information along with the date and time of entry as a record in a database (See Aquila, Page 12, Paragraphs 0226-0229)” (Answer 4). In our view, it was not necessary to rely on Aquila because storing information as records in databases *per se* was generally known to those of ordinary skill in the art at the time of the

invention. There is no evidence that *insurance* and the *date and time of entry* is anything other than a type of information and, as such, is patentably inconsequential nonfunctional descriptive material.

Finally, we note that the total of Appellant's argument are two sentences, the first contending that the Examiner "has not shown that the disclosure relied on to reject Applicant's claims was included in the provisional patent application" (Br. 7) and the second concluding that "the Examiner has failed to make a *prima facie* case which would support a rejection of Applicant's claims under 35 U.S.C. [§] 103(a)" (Br. 7). These bare statements devoid of any further analysis do not persuade us that the Examiner was obligated, as part of establishing the *prima facie* case of obviousness, to provide a showing that the subject matter the Examiner relied upon in Aquila to reject the claim is "included" in the 60/194,128 provisional application. *Cf. Yamaguchi*, 88 USPQ2d at 1613 ("a mere conclusory statement totally devoid of explanation or analysis hardly persuades us of error in the Examiner's factual findings pertaining to the Narayanan patent and its provisional application").

Turning now to the issue of whether Almeida discloses "certificates of insurance" and "certificate holders" as recited in the claims, we agree with the Appellant that Almeida does not clearly show these. We have reviewed the passages in Almeida that the Examiner relied upon (see FF 9-14) but do not see there any mention of "certificates of insurance" or "certificate holders." Claims are required to be given the broadest reasonable construction in light of the Specification as they would be interpreted by one of ordinary skill in the art. "[C]laims are to be read in the light [of the specification], not in a vacuum." *In re Dean*, 291 F.2d 947, 951 (CCPA

1961). The written description is “always highly relevant” in construing a claim, and “it is the single best guide to the meaning of a disputed term.”

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). In that regard, the Specification provides specific definitions for the claim terms “certificates of insurance” or “certificate holders.” FF 6 and 7. In light of the definitions, the “certificates of insurance” or “certificate holders” as claimed do not equate to the “digital certificates” or holders thereof that Almeida discloses. FF 9.

However, we are not persuaded by the Appellant’s argument that a patentable distinction exists between the “certificates of insurance” as claimed and Almeida’s digital certificates. We understand that “certificates of insurance” have a particular function and purpose in commerce. But the certificate gets that particular function and purpose from the information on the certificate. Almeida’s certificates also contain information (“about the holder’s identity such as name, location, and/or a private identification number (PIN) obtained upon registering for access to the electronic common area 216,” FF 9), albeit information that is different from that of “certificates of insurance.” In that respect, the Appellant is correct that the “certificates of insurance” as claimed have a different purpose and function than that of Almeida. But the difference in function and purpose between them is attributable to the different types of information they carry.

The information the certificates carry are nonfunctional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the

substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d at 1338. *See also Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; WL 2433879, affirmed without written opinion Aug. 17, 2006). In that regard, the Appellant has not shown a new and unobvious functional relationship between the insurance information and the certificate that would lead us to conclude that the “certificates of insurance” as claimed are patentably different from the certificates Almeida discloses.

Accordingly, while we agree that Almeida does not disclose “certificates of insurance” and “certificate holder” as recited in the claims, the difference between them and the certificate and holder that Almeida discloses is one of nonfunctional descriptive material which, as such, does not make the difference a patentable one.

All the arguments having been addressed, we find that the Appellant has not shown error in the rejection of claim 1.

Claims 2-4 and 11-13

The Appellant relies on the arguments challenging the rejection of claim 1 in challenging the rejection of claims 2-4 and 11-13. Br. 10. Since we found them unpersuasive as to error in the rejection of claim 1, we reach the same conclusion as to the error in the rejection of claims 2-4 and 11-13.

Claim 6

The Appellant states, without further elaboration, that the cited references fail to teach or suggest the claim limitation ““comparing the insurance record for the insured to the user-specified insurance requirement of the certificate holder.”” Br. 10. “It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art.” *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991). *See also In re Wiseman*, 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be presented to the board). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Claims 7-9 and 14

The Appellant relies on the statement made in challenging the rejection of claim 6 to challenge the rejection of claims 7-9 and 14. Br. 10. Since we did not consider the statement challenging the rejection of claim 6 to be an argument for separate patentability of claim 6, we reach the same conclusion as to the statement as applied to the rejection of claims 7-9 and 14.

Claims 15-22

Claims 15-22 have not been separately argued. Accordingly, they stand or fall with claims 1-4, 6-9, and 11-14. Therefore, we reach the same

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conclusion as to the rejection of these claims, i.e., the Appellant has not shown error in the rejection claims 15-22.

CONCLUSIONS

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1-4, 6-9, and 11-22 under 35 U.S.C. § 103(a) as being unpatentable over Almeida, Aquila, and Sexton.

DECISION

The decision of the Examiner to reject claims 1-4, 6-9, and 11-22 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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